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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,078	09/24/2001	Rafael Pi Subirana	H-3734 PCTUS	9173

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COGNIS CORPORATION
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EXAMINER

BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/857,078

Applicant(s)

PI SUBIRANA ET AL.

Examiner

Barbara P. Badio, Ph.D.

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-- Th MAILING DATE of this communication appears on th cover sheet with the corresp ndenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-20 is/are allowed.
- 6) ☒ Claim(s) 21-26, 29 and 30 is/are rejected.
- 7) ☒ Claim(s) 27 and 28 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

Second Nonfinal Office Action on the Merits

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

2. The rejection of claims 10-30 under 35 USC 112, first paragraph is withdrawn.

Claim Rejections - 35 USC § 102

3. The rejections of claims 21 and 22 under 35 USC 102(b) over Cremlyn et al. or Ramirez et al are maintained.

Applicant's argument against the above-cited references is centered around the processes taught by the prior art in the preparation of the claimed sterol phosphates. Applicant's argument was considered but not persuasive for the following reason.

The patentability of a product does not depend on its method of production. According to the MPEP, "if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process". (see MPEP § 2113). Therefore, the compounds recited by the instant claims encompass the sterol phosphates taught by the prior art even though, different processes made the prior art compounds.

For this reason, the rejections of claims 21 and 22 under 35 USC 102(b) over Cremlyn et al. or Ramirez et al are maintained.

Claim Rejections - 35 USC § 103

4. The rejection of claims 10-20 under 35 USC 103(a) over Okamoto and Cremlyn et al. or Ramirez et al. in combination is withdrawn.

5. Claims 23-26, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simonnet ('433) and Ribier et al. ('250) in combination.

Simonnet et al. teach a stable dispersion containing a lipid vesicle comprising a lamellar phase formed of at least one silicone surfactant (see the entire article, especially col. 1, lines 61-66). The reference also teaches (a) that it is advantageous to add an ionic amphiphilic lipid such as the alkali metal salts of cholesterol phosphate because it enhances the stability of the dispersion by inhibiting flocculation (see col. 3, lines 24-38), (b) the amphiphilic ionic lipids are present at concentrations ranging from 0 to 20% by weight of the silicone surfactant (col. 3, lines 58-61) and (c) the vesicles may contain one or more active compounds, such as, cosmetic and/or dermatological active agents such as antibacterial agents, antiperspirants, deodorants etc. (see col. 4, line 20 – col. 5, line 50).

Ribier et al. teach a cosmetic composition containing a dispersion of vesicles formed from a lipid-phase membrane containing at least one ionic and/or nonionic amphiphilic lipid encapsulating an aqueous phase and at least one agent that stabilizes

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said vesicles (see the entire article, especially col. 5, line 65 - col. 6, line 27; col. 10, lines 26-37; claims 7 & 18). The reference teaches ionic amphiphilic lipids such as cholesterol acid phosphate and its alkali metal salts (see col. 8, line 45 - col. 9, line 6).

Based on the teachings of the above-cited references, the incorporation of cholesterol acid phosphate or its alkali metal salts in cosmetic compositions would have been obvious to the skilled artisan at the time of the present invention. The motivation to add cholesterol acid phosphate or its alkali metal salts to cosmetic compositions is based on the prior art teaching that ionic amphiphilic lipids provide stability to dispersions contained in compositions such as cosmetic composition.

Allowable Subject Matter

6. Claims 10-20 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter:

The rejection under 35 USC 103(a) is withdrawn in light of applicant's argument that the prior art does not teach the utilization of polyphosphoric acid (RN 10380-08-2). The closest prior art teaches silyl polyphosphate derivatives (see Okamoto, Bull. Chem. Soc. Jpn., vol. 58, 3393-3394, 1985). The prior art provides no motivation to modify the prior art process utilizing polyphosphoric acid, i.e., RN 10380-08-2, in order to obtain the claimed process.

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8. Claims 27 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Telephone Inquiry

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Barbara P. Badio, Ph.D.
Primary Examiner
Art Unit 1616

BB
May 7, 2003